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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,229	05/28/2002	Nensuke Tanaka	08566.0002	2650
22852 7590 08/10/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER BASIT, ABDUL	
			ART UNIT 3694	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/031,229	<b>Applicant(s)</b> TANAKA ET AL.	
	<b>Examiner</b> Abdul Basit	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-5, 7-9, 12, 13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 7-9, 12-13 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to the amendment filed on 3/16/2007. Claims 3-5, 7-9, 12-13 and 16 are pending. Applicant has cancelled claims 1-2, 6, 10, 11, 14 and 15. Claims 3-5, 7-9, 12-13 and 16 are examined.

### **RESPONSE TO ARGUMENTS**

1. Applicant's arguments filed on 3/16/2007 have been fully considered.
2. In response to Applicant's arguments with respect to Examiner's rejection of claim 4, Applicant's amendments have overcome the 35 USC 112 rejection. Examiner's 35 USC 112 rejection is withdrawn.
3. In response to Applicant's arguments regarding Examiner's rejection of claims 3-5, 9 and 16, Examiner's 35 USC 102 rejection remains in place.
4. In response to Applicant's argument regarding claim 12, Applicant's amended has resulted in Applicant's arguments moot because a new search has been necessitated by amendment. Claim 12 is now rejected under 35 USC 103. Claim 13 which depends on claim 12 is also rejected under 35 USC 103.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 3-5, 9 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Berckmans (US Pat. No. 6,876,981).

***Regarding claim 3:***

Berckmans teaches a transmission method for stock price information, comprising:  
a stock price update step of successively updating and storing information on stock prices, (*see column 4, lines 8-9*)

a condition input step of inputting one or more conditions of a technical index ~~concerning~~ and a stock price trend of a name to be notified to a customer,  
a condition detection step of detecting by a condition detection server whether said stock price updated by said stock price update step satisfies said one or more conditions input by said condition input step or not, (*see column 4, lines 58-67*) and  
a notification step of, when said one or more conditions are satisfied at said condition detection step, notifying said customer of the satisfaction by electronic mail. (*see column 4, lines 10-16 and column 5, lines 5-15*).

Applicant argues that Berckmans does not teach a condition detection step. According to Webster's II Dictionary (3<sup>rd</sup> Edition, 2005), the definition of condition is as

follows: "...4. A requirement: prerequisite. 5. Something that restricts or modifies: qualification." The investment server determines which clients must be informed of new data that is received. This inherently means that other clients will not be informed of new data that is received. Berckmans teaches that there has to be an prerequisite or a qualification that some clients will be informed and other clients will not be informed of new data. (*see column 4, lines 58-67*). Therefore Berckmans teaches a condition detection step.

Applicant also argues that Berckmans does not teach a condition detection server. The investment server is the condition detection server. (*see column 4, lines 58-67*).

***Regarding claim 4, 5, 9, and 16:***

Applicant has provided no arguments regarding the validity of claims 4,5, 9, and 16, other than they should be allowable because claim 3 is allowable. Since the office has shown claim 3 is still anticipated by Berckmans, claims 4, 5, 9, and 16 also remain rejected.

***Regarding claim 4:***

Berckmans teaches a transmission method for stock price information according to ~~Claim 2~~ or claim 3, wherein said information notified by said notification step includes said stock price trend of said name. (*see column 4, lines 1-9*).

***Regarding claim 5:***

Berckmans teaches a transmission method for stock price information according to ~~Claim 2~~ or claim 3, wherein said condition detection step detects whether said input

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one or more conditions are satisfied or not every ~~[[a]]~~ predetermined time period. (see column 4, lines 10-16).

**Regarding claim 9:**

Berckmans teaches a transmission method for stock price information according to ~~Claim 2~~-claim 3, wherein there are a plurality of addresses of said electronic mail notified by said notification step. (see column 4, lines 62-64).

**Regarding claim 16:**

Applicant provides no argument for allowing claim 16, other than claim 16 should be allowed because claim 3 is allowable. Because Examiner has maintained the rejection of claim 3, claim 16 also remains rejected under 35 USC 102.

Berckmans teaches a transmission system for stock price information, (see column 4 generally) ~~composing~~-comprising:

- A notification information data base for storing one or more conditions for notification of a technical index ~~concerning notification of~~ and a stock price of a specific name input from a customer terminal connected to a network and a customer's mail address in correspondence to each other, (see column 4, lines 10-16).
- A stock price storage server for updating and storing said stock price of said specific name on a market, (see column 4, lines 8-9).
- A condition detection server for detecting whether said technical conditions stored in said notification information data base are satisfied or not using said

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stock price of said specific name stored in said stock price storage server, (see *column 4, lines 55-67*) and

- A stock price notification mail server for transmitting, when said condition detection server detects that said stock price of said specific name satisfies said technical conditions, electronic mail to said customer mail address corresponding to said technical conditions. (see *column 4, lines 10-16*).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-8 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berckman in view of Wesley Iverson's, "Stock trading goes wireless," November 1998, Financial Services Online, page 24

***Regarding claim 7:***

Iverson teaches a transmission method for stock price information according to wherein in said electronic mail notified by said notification step, an address of a home page linked to a current market is mentioned. (see page 1). Iverson suggests this by discussing how consumers can use laptop personal computers to connect with web-based brokerages. (see page 22).

***Regarding claim 8:***

Iverson teaches a transmission method for stock price information according to claim 3,

wherein in said electronic mail notified by said notification step, an address of a home page linked to a certification screen to a stock buying and selling form is mentioned.

Iverson suggests this by discussing how consumers can use laptop personal computers to connect with web-based brokerages. (see page 22).

5. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berckman in view of Matt Haig's article, "Online: E-commerce: Spread it by word or mouse: Why pay for banner ads when you can get customers to sell your product for you on the net?" (The Guardian - UK, February 15, 2001, page 14).

***Regarding claim 12:***

Berckman teaches:

- A method for a customer terminal, comprising: [[for]] transmitting and receiving stock price information[[.]]; (see column 5, lines 59-63).
- Displaying a screen for promoting to input one or more conditions concerning stock prices[[.]]; (see column 5, lines 59-63) and
- Transmitting said one or more conditions input on said screen, and when said input conditions are satisfied, receiving information of the ~~satisfaction~~ satisfaction by electronic mail[[.]]; (see column 5, lines 59-63).

Haig, not Berckman teaches that an address of a home page of a predetermined form of stock buying and selling is displayed in contents of said received electronic mail.

Berckman teaches that when said address is clicked, a predetermined name with said one or more conditions input is input and displayed on said predetermined form. (see page 1).



It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Berckmans with Haig. Motivation to modify exists because the ability for investors to stay in constant contact with the market, as discussed in the Iverson prior art (see page 22).

***Regarding claim 13:***

Applicant has provided no argument for claim 13. Because claim 12 remains rejected, claim 13 is still rejected.

Berckman teaches a customer terminal for transmitting and receiving stock price information according to claim 12, wherein on a same screen as said input screen, whether said electronic mail to be transmitted when said one or more conditions are satisfied is already transmitted or not is displayed. (*see column 5, lines 1-16*).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdul Basit whose telephone number is 571 272-7246. The examiner can normally be reached on Monday - Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

aqb

  
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